

REMARKS

Claims 1-4, 7-9, 11-12, and 14-24 were pending and rejected in an Office Action dated April 17, 2009. In response, claim 24 is amended. Claims 1-4, 7-9, 11-12, and 14-24 are pending upon entry of this amendment. These changes are believed not to introduce new matter, and their entry is respectfully requested. In view of the Amendments herein and the Remarks that follow, Applicant respectfully requests that Examiner reconsider all outstanding rejections, and withdraw them.

Summary of Substance of Interview

On May 28, 2009, a telephone interview was held between Applicant's representative, Nikhil Iyengar (Reg. No. 60,910), Examiner Tae Kim, and Examiner Alex Wang. The declaration under 35 CFR § 1.131 was discussed. The Examiners agreed that if actual reduction to practice is shown prior to the reference date, then diligence does not need to be shown.

Applicant's representative and Examiner Kim further discussed the requirements for showing actual reduction to practice. The Examiner stated that while Exhibit C of the declaration shows code for comparing colors, it does not show how the comparison values generated in the code are used for "deleting from the electronic message foreground characters from said portions, to form a redacted electronic message" and "forwarding the redacted electronic message to a spam filter." The Examiner also stated that further evidence may be needed to show that the invention has been sufficiently tested.

Response to Rejection Under 35 USC § 112

In the Office Action, the Examiner rejected claim 24 as failing to comply with the written description requirement under 35 USC § 112, first paragraph. Specifically, the Examiner stated that the specification does not disclose how the current invention provides for “determining whether a monitor associated with a recipient of the electronic message is a liquid crystal display (LCD) monitor” as recited in claim 24. This limitation has been removed in claim 24 as amended herein and as a result the rejection is overcome.

Response to Rejections Under 35 USC § 103

In the Office Action, the Examiner rejected claims 1-4, 7-9, and 11-12 and 14-24 as being obvious under 35 USC § 103. Claims 1-3, 7-9, 11, 12, and 14-23 were rejected in view of U.S. Patent Publication No. 2004/0221062 (“Starbuck”) and U.S. Patent No. 5,751,847 (“Wuyts”). Claim 4 was rejected in view of Starbuck, Wuyts, and U.S. Patent Publication No. 2002/0113801 (“Reavy”). Claim 24 was rejected in view of Starbuck, Wuyts, and U.S. Patent Publication No. 2002/0163527 (“Park”). These rejections are respectfully traversed.

Starbuck does not qualify as prior art under 35 USC § 102(e) because the claimed subject matter was actually reduced to practice before Starbuck’s filing date of May 2, 2003. To antedate Starbuck, Applicant submits herewith a declaration and supporting exhibits pursuant to 35 CFR § 1.131. See, e.g., MPEP 715.07.III. This declaration supersedes the previous declaration dated March 2, 2009 submitted with Amendment B. Since all of the claim rejections under 35 USC § 103 in the Office Action depend on

Starbuck, the rejections of all of the claims are overcome.

In the Office Action, the Examiner stated that the (previous) declaration under 37 CFR 1.131 dated March 2, 2009 is “insufficient to establish diligence from a date prior to the date of reduction to practice of the Starbuck reference to either a constructive reduction to practice or an actual reduction to practice.” However, in the telephone interview of May 28, 2009, the Examiner agreed that diligence does not need to be shown if the actual reduction to practice occurred before Starbuck’s filing date of May 2, 2003. Also see MPEP 715.07.III.

The Applicant notes that all of the requirements for actual reduction to practice as mentioned in MPEP 2138.05.II – IV are shown by the attached declaration. For example, see sections 2.d, 2.e., 2.f, and 2.g of the attached declaration. The applicant also notes that some dates have been redacted from the exhibits to the declaration as provided by MPEP 715.07.II, which states “if the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration ... if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date.”

The Applicant further notes that the statements in the attached declaration are themselves facts, whether the statements are associated with an exhibit or not. As stated in MPEP 715.07.I, “evidence in the form of exhibits **may** accompany the affidavit or declaration” (emphasis added). MPEP 715.07.I further states “an accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself.” The statements in the attached declaration are specific facts that show actual reduction to practice.

As mentioned above, the Examiner stated in the interview that while Exhibit C of the declaration shows code for comparing colors, it does not show how the comparison values generated in the code are used for “deleting from the electronic message foreground characters from said portions, to form a redacted electronic message” and “forwarding the redacted electronic message to a spam filter.” In response, Applicant notes that section 2.d.6. of the attached declaration describes the operation of the code for performing these steps and describes the integration of that code with the code in Exhibit C. Further, section 2.d.7. includes an explanation for not providing a copy of this code as an exhibit to the declaration.

As mentioned above, the Examiner stated in the interview that further evidence such as documented test results may be needed to show that the invention has been sufficiently tested. In response, Applicant notes that Exhibit C mentions “several weeks of testing hundreds of monitors” using the code (see section 2.f.3 of the attached declaration). Also, Exhibit A, section 5, “Construction and Test of Product/Technology” mentions that the construction and testing of the invention to the extent required by MPEP 2138.05 (which states “For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development.”) was completed prior to May 2, 2003.

Further, sections 2.f.1-4. of the attached declaration provide facts showing the testing of the complete invention in accordance with MPEP 2138.05. For example, section 2.f.1 mentions that “the code was determined to be able to ignore (or delete) non-visible text within the HTML files when performing spam filtering.” Applicant notes that

there is no requirement in the MPEP or elsewhere for the presentation of detailed test results in exhibits.

Applicant respectfully invites Examiner to contact Applicant's representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,
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